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REMARKS

This is a full and timely response to the non-final Official Action mailed May 8, 2007. Reconsideration of the application in light of the following remarks is respectfully requested.

Claim Status:

No amendments to the application are proposed by the present paper. Thus, claims 1-53 are currently pending for further action.

Prior Art:

Claims 1-6 were rejected as anticipated under 35 U.S.C. § 102(e) over the teachings of U.S. Patent App. Pub. No. 2003/0147095 to Karn ("Karn"). For at least the following reasons, this rejection is respectfully traversed.

Claim 1 recites: "A method of providing email messages to a printing device, said method comprising attaching a memory module storing said email messages to a printing device consumable." In contrast, Karn does not teach or suggest any of this subject matter.

The Office Action does not appear to understand what a "printing device consumable" is. Consequently, it may be helpful to refer to Applicant's specification.

In order to produce hardcopy documents, a printer or printing device uses supplies of materials that are "consumed" as documents are printed. Such consumables include, for example, toner and print media. As used herein and in the appended claims, "toner" shall be broadly defined to include any material that is selectively distributed by a printer or printing device on a print medium to form an image. Thus, "toner" includes, but is not limited to, ink, toner, colorant, printing fluid, etc. "Print media" or a "print medium" shall be broadly defined as any medium on which a printer or printing device prints an image. For example, types of "print media" include, but are not limited to, paper, cardboard, card stock, transparencies, vinyl, etc.

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As used herein and the appended claims, the term "consumable" shall be defined to mean any material consumed by a printing device to produce hardcopy documents. For example, a consumable may be toner and the disposable cartridge or container that contains the toner in the printing device. A consumable may also be a stack or supply of print media. In addition to toner and print media, a "consumable" may be any part or portion of a printer or printing device that is periodically replaced to allow the printer or printing device to continue producing printed hardcopy documents.

(Applicant's specification, paragraphs 0005-6).

As noted above, claim 1 recites "attaching a memory module storing ... email messages to a printing device consumable." Karn utterly fails to teach or suggest this subject matter.

According to the Office Action, "Karn states 'The invention is directed to methods and systems for providing email access on any printing-capable device (fig. 1 printer 12) which is networked with a mail server.' (page 1 paragraph 5 line 1) 'The device enables the user to retrieve email messages from a mail server and prints out messages selected by the user. (page 1 paragraph 5 line 7)." (Action of 5/8/07, p. 2). This, however, clearly has nothing to do with the method actually recited in claim 1.

Karn, as cited by the Office Action, does not even mention a printing device consumable. Moreover, Karn clearly does not teach or suggest "attaching a memory module storing ... email messages to a printing device consumable." The Office Action utterly fails to indicate how or where this subject matter is taught by Karn.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. For at least these reasons, the rejection based on Karn of claim 1 and its dependent claims should be reconsidered and withdrawn.

Additionally, various dependent claims of the application recite subject matter that is further patentable over the cited prior art. Specific, non-exclusive examples follow.

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Claim 2 recites "installing said printing device consumable in said printing device; and interfacing said printing device and said memory module." In this regard, the Office Action cites a portion of Karn that has to do with programming a printer, and has nothing to do with installing a consumable in that printer or printing device. (Action of 5/8/07, pp. 2-3).

Karn clearly fails to anticipate or suggest the subject matter of claim 2.

Claim 4 recites "uploading an email message interface from said memory module to a memory of said printing device." Applicant's specification defines an email message interface as an interface that "can be uploaded by a printer or printing device and used to access the email messages (103) that remain on the memory module (110)" on a printing device consumable. (Applicant's specification, paragraph 0020). Karn clearly does not teach or suggest any such subject matter.

In this regard, the Office Action cites a portion of Karn that describes interaction between a printing device and a mail server. (Action of 5/8/07, p. 3). This has nothing to do with, and Karn does not teach or suggest, a memory module *on a printing device consumable* from which an email message interface, as defined by Applicant, is uploaded. Thus, Karn clearly fails to anticipate or suggest the subject matter of claim 4.

Claim 5 recites "executing said email message interface with a controller of said printing device." Claim 6 recites "using said email messages on said memory module through said email message interface." Clearly Karn does not, and cannot, teach or suggest this subject matter.

For at least these additional reasons, the rejection of each of the indicated claims should be reconsidered and withdrawn.

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Claims 7-20 and 22-35 were rejected under 35 U.S.C. § 102(e) by U.S. Patent No. 6,622,266 to Goddard et al. ("Goddard"). For at least the following reasons, this rejection is respectfully traversed.

Claim 7 recites:

A method for providing email messages for email alerts from a printing device, said method comprising:
storing email messages on a memory module;
attaching said memory module to a printing device consumable;
installing said printing device consumable with attached memory module in a printing device; and
interfacing said memory module with said printing device.

In contrast, Goddard fails to teach or suggest this subject matter.

The recent Office Action refers to Goddard as teaching a memory module shown in Fig. 2, element 218. (Action of 5/8/07, p. 4). In reality, this is not a mere memory module, but is an "enterprise e-mail server." (Goddard, Fig. 2; col. 4, line 59). Goddard does not teach or suggest, nor would it be reasonable to suggest, that the "enterprise email server" (218) is attached to a printing device consumable which is then installed in a printing device, i.e., "installing said printing device consumable *with attached memory module* in a printing device." (Emphasis added).

Thus, Goddard is completely inapposite to claim 7 and fails to teach or suggest any of the claimed subject matter. "A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. For at least these reasons, the rejection based on Goddard of claim 7 and its dependent claims should be reconsidered and withdrawn.

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Additionally, various dependent claims of claim 7 recite subject matter that is further patentable over the cited prior art. Specific, non-exclusive examples follow.

Claim 8 recites "wherein said printing device consumable comprises a toner cartridge." In contrast, Goddard does not teach or suggest attaching a memory module to a toner cartridge.

Claim 9 recites "uploading said email messages from said memory module to a memory unit of said printing device." In contrast, Goddard does not teach or suggest uploading email messages from a memory module attached to a printing device consumable.

Claim 14 recites "wherein said email message comprises an order for additional consumables sent to a provider of said consumables." Goddard fails to teach or suggest an email message comprising an order for additional consumables that is stored in a memory module that is attached to a printing device consumable.

Claim 17 recites "uploading an email message interface from said memory module to said printing device; and accessing said email messages on said memory module with said email message interface." Applicant's definition of an email message interface was discussed above. In contrast, Goddard utterly fails to teach or suggest this subject matter.

Claim 25 recites:

wherein said uploading said email message elements to printing device memory comprises:
determining if previous email message elements already exist in said printing device memory; and
uploading said email message elements to printing device memory if no previous email message elements are found

In contrast, Goddard utterly fails to teach or suggest this subject matter. The Office Action unreasonably regards this subject matter as inherent in Goddard. (Action of 5/8/07, p. 9).

This is clearly incorrect.

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"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.' 'Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (citations omitted). "[T]he examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990) (emphasis in original); see also, MPEP § 2112 (quoting *Levy*). Clearly, the Office Action fails to establish that the subject matter of claim 25 is inherent in the teachings of Goodard.

Claim 26 recites:

wherein said uploading said email message elements to printing device memory comprises:
determining if previous email messages already exist in said memory unit of said printing device; and
performing a replacement action if previous email message elements are found.

In contrast, Goddard utterly fails to teach or suggest this subject matter. Again, the Office Action unreasonably regards this subject matter as inherent in Goddard. (Action of 5/8/07, p. 9). As demonstrated above, this is unreasonable and cannot support a rejection of claim 26.

For at least these additional reasons, the rejection of the indicated claims should be reconsidered and withdrawn.

Independent claim 30 recites:

A method for providing email messages for email alerts from a printing device, said method comprising:
storing email messages and an email message interface on a memory module;

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attaching said memory module to a printing device consumable;
installing said printing device consumable with attached memory module in a
printing device; and
uploading said email message interface to a printing device memory.
(Emphasis added).

As demonstrated above, Goddard does not teach or suggest a method that includes "attaching [a] memory module to a printing device consumable." Consequently, Goddard also cannot teach or suggest "storing email messages" in such a memory module. Goddard also does not teach or suggest the idea of "an email message interface" as defined and claimed by Applicant and, therefore, cannot teach or suggest storing such an interface in a memory module as claimed. Goddard does not teach or suggest "installing said printing device consumable *with attached memory module* in a printing device." (Emphasis added). Finally, Goddard does not teach or suggest "uploading said email message interface to a printing device memory." In short, Goddard does not anticipate, teach or even suggest any of the subject matter of claim 30.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. For at least these reasons, the rejection based on Goddard of claim 30 and its dependent claims should be reconsidered and withdrawn.

Additionally, various dependent claims of claim 30 recite subject matter that is further patentable over the cited prior art. Examples of such claims are similar to the examples given above with respect to the dependent claims of independent claim 7.

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Claims 36-40 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent App. Pub. No. 2002/0188504 to Whale ("Whale"). For at least the following reasons, this rejection is respectfully traversed.

Claim 36 recites:

A method of providing a customized list of email messages for use by a printing device, said method comprising:
receiving email messages from a purchaser of a printing device consumable;
storing said email messages on a memory module attached to said printing device consumable.

In this regard, the Office Action cites Whale at paragraph 0056. That portion of Whale reads as follows.

The promotion initiation component is further configured to initiate promotional actions, directed to operators of particular print systems, in response to detected or calculated changes in consumable product usage by said particular print systems. Such promotional actions might comprise a variety of things, such as simply notifying the customer or presenting or proposing alternative purchase contracts for consumable products. Promotional proposals such as this might be presented during the normal ordering process, as email descriptions of purchase options, or even by personal contact from a representative or salesperson of the vendor.
(Whale, paragraph 0056).

It is entirely unclear how the Office Action reads this as anticipating the claimed method of receiving email messages from a purchaser of a printing device consumable and storing those email messages on a memory module attached to a printing device consumable.

The Office Action also cites Whale at paragraph 0037. This portion of Whale reads as follows.

The memory 134 of the printer 120 also stores vendor information 142 that includes data about the vendor system 102 (FIG. 1), e.g., name, address, email address, remote access number, etc., for a vendor from which replaceable components may be ordered. The supplies monitoring component 138 uses the vendor information 142 to contact the vendor system and place an order for a printing device replaceable component.
(Whale, paragraph 0056) (emphasis added).

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Again, it is entirely unclear how the Office Action reads this as anticipating the claimed method of receiving email messages from a purchaser of a printing device consumable and storing those email messages on a memory module attached to a printing device consumable.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. For at least these reasons, the rejection based on Whale of claim 36 and its dependent claims should be reconsidered and withdrawn.

Claims 41-53 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent App. Pub. No. 2003/0002074 to Miyano ("Miyano"). For at least the following reasons, this rejection is also respectfully traversed.

Claim 41 recites:

A consumable for use with a printing device, said consumable comprising:
a printing device consumable;
a memory module attached to said printing device consumable; and
email messages stored on said memory module.

In contrast, Miyano does not teach or suggest this subject matter.

According to the Office Action, Miyano teaches the claimed "consumable" at Fig. 1. (Action of 5/8/07, p. 15). This is clearly incorrect. Fig. 1 of Miyano shows a "printer," (Miyano, Fig. 1). There is no printing device consumable explicitly illustrated in Fig. 1. One of skill in the art could not fail to appreciate the difference between a printer and a consumable used by such a printing device.

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The Office Action does not indicate how or where Miyano teaches the claimed memory module attached to a printing device consumable. Miyano does not appear to teach or suggest any such subject matter. Miyano further does not teach or suggest "email messages stored on said memory module" attached to a printing device consumable. In this regard, the Office Action cites portion of Miyano that have to do with email messages received by maintenance providers monitoring the status of a printer. (Action of 5/8/07, p. 15). However, this clearly does not anticipate the claimed consumable with email messages stored in an attached memory.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. For at least these reasons, the rejection based on Miyano of claim 41 and its dependent claims should be reconsidered and withdrawn.

Additionally, various dependent claims of claim 41 recite subject matter that is further patentable over the cited prior art. Non-exclusive examples follow.

Claim 42 recite "further comprising a wireless interface for said memory module for interfacing and communicating with a printing device." In this regard, the Office Action cites, instead, teachings regarding the interface between a network interface (112) and networked servers (150, 160). (Action of 5/8/07, p. 15). This is clearly irrelevant to the claimed interface between a memory module on a printing device consumable and the printing device in which the consumable is installed.

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Claim 46 recites "an email message interface stored on said memory module which, when uploaded to a printing device, allows access and use of said email messages on said memory module." In contrast, Miyano does not teach or suggest an email message interface as defined and claimed by the Applicant. Accordingly, Miyano fails to teach or suggest the subject matter of claim 46.

For at least these additional reasons, the rejection of the indicated claims should be reconsidered and withdrawn.

Claim 47 recites:

A printing device comprising:
a printing device controller with an email engine for using email messages provided by a memory module attached to a printing device consumable;
a printing device memory storing said email engine; and
a printing device interface disposed and configured to interface and communicate with said memory module attached to a printing device consumable supplied to said printing device.

As demonstrated above, Miyano does not teach or suggest "a memory module attached to a printing device consumable." Consequently, Miyano cannot teach or suggest "a printing device controller with an email engine for using email messages provided by a memory module attached to a printing device consumable." Miyano also does not teach or suggest "a printing device interface disposed and configured to interface and communicate with said memory module attached to a printing device consumable supplied to said printing device."

The citations of the Office Action to Miyano are completely irrelevant to the subject matter actually recited in claim 47. (Action of 5/8/07, p. 17).

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art

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reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. For at least these reasons, the rejection based on Miyano of claim 47 and its dependent claims should be reconsidered and withdrawn.

Additionally, various dependent claims of claim 47 recite subject matter that is further patentable over the cited prior art. Examples of such claims are similar to the examples given above with respect to the dependent claims of independent claim 41.

Claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Goddard and Whale. This rejection is respectfully traversed under 35 U.S.C. § 103(c).

35 U.S.C. § 103(c) states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (c), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Applicant notes that Whale is available as prior art against the present application only under 35 U.S.C. § 102(e). The Office also recognizes this fact as Whale was elsewhere applied by the outstanding Office Action under § 102(e). (Action of 5/8/07, p. 13). Applicant also notes that Whale is assigned to the Hewlett-Packard Development Co., L.P. (See, recorded assignment at reel/frame 014061/0492)

Similarly, the present application is also assigned to Hewlett-Packard Development Co., L.P. (See, recorded assignment at reel/frame 014149/0989). Applicant hereby states that

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the subject matter of the present application and the Whale reference were, at the time the invention of the present application was made, owned by, or subject to an obligation of assignment to, the same person, i.e., Hewlett-Packard Co. (See MPEP § 706.02(1)(2)).


Consequently, under 35 U.S.C. § 103(c), the Whale reference *cannot* be applied as prior art against the present application under 35 U.S.C. § 103(a). Therefore, the listed rejection of claim 21, which applies Whale under § 103(a), must be reconsidered and withdrawn.

Conclusion:

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: August 8, 2007


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